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10/723,761

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EXAMINER

CHAPMAN, GINGER T

ART UNIT

PAPER NUMBER

3761

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|---|--|
| Office Action Summary | Application No. 10/723,761 | Applicant(s) MACDONALD ET AL. | |
| | Examiner Ginger T. Chapman | Art Unit 3761 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 22-28 and 32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 22-28 and 32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2007 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

1. In view of the appeal brief filed on 1 July April 2009, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/Tatyana Zalukaeva/

Supervisory Patent Examiner, Art Unit 3761

Status of the claims

2. Claims 17-18, 22-28 and 32 are pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claims 17-18, 25-28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitting et al (EP 0 392 528 A2) in view of Dudley et al (US 3,340,875).

3. With respect to claim 17, as best depicted in Figure 4, Fitting discloses a personal care product (p. 14, ll. 111) comprising:

4. a liquid impervious baffle 37;
 5. a liquid pervious liner 39;
 6. an absorbent core 31 positioned between the baffle 37 and the liner 39; and
- an odor sorbent substrate 33 positioned between the baffle 37 and absorbent core 31 in a manner that one or more sides are left open (fig. 4), wherein the substrate 33 has a surface that is coated with a durable activated carbon ink, the activated carbon ink consisting essentially of activated carbon particles and a binder (p. 8, ll. 54-55; p. 9, ll. 15-22; p. 19, ll. 21-22 and ll. 57-58).

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7. Fitting discloses the claimed invention except for the substrate wrapped around the absorbent core. Fitting teaches the substrate positioned between the baffle and the core in order to absorb odors emanating from the core, thus providing motivation for such.

8. As best depicted in Figure 2, Dudley teaches an odor sorbent 10 comprising activated carbon (c. 3, l. 25) positioned between a baffle 9 and an absorbent core 5, 8, 4 in a manner such that one or more of the sides are left open, i.e., Dudley at c. 2, ll. 52-56 teaching positioning the odor sorbent in a U-shaped fashion. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the odor sorbent substrate of Fitting wrapped around the core such that one or more sides are left open as taught by Dudley since Dudley states, at c. 1, ll. 28-30 and ll. 28-30, that the benefit of forming the odor sorbent with this design is that it ensures substantially complete coverage of effective areas of the sanitary napkin.

16. The examiner notes, with respect to the claimed ink, that the only inks disclosed in the instant Specification are all commercially available from: MeadWestvaco Corporation of New York, NY, USA; Calgon Carbon Corporation of Pittsburg, PA, USA and Sigma-Aldrich Chemical Company of Milwaukee, WI, USA and Cabot Corporation of Boston, MA, USA.

17. Since said inks are commercially available for their odor sorbent properties, said use of commercially available products lacks *ipso facto* novelty.

18. With respect to claim 18, Fitting discloses the personal care product is selected from the group consisting of diapers, training pants, adult incontinence products, and feminine hygiene products (p. 2, ll. 3-4; p. 14, l. 1).

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19. With respect to claims 25-27, Fitting discloses the substrate contains a film, nonwoven web, coform web, airlaid paper web, wetlaid paper web or a combination thereof (p. 4, l. 43, l. 50-51, l. 53; p. 7, ll. 5-21 and ll. 29-30).

20. With respect to claim 28, fitting discloses the binder is a styrene-acrylic binder (p. 8, ll. 17-19).

21. With respect to claim 32, Fitting discloses the ink is applied to the substrate as an aqueous solution (p. 6, ll. 1-2, ll. 9-14).

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

3.

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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4. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitting in view of Dudley et al (US 3,340,875) and further in view of Giglia et al (US 4,564,727) and Fujinami et al (US 3,939,838).

22. With respect to claims 22-24, the combination of Fitting and Dudley disclose the claimed invention except for the activated carbon particles are present in an amount of between about 2 and 80 wt.% (**claim 22**); 5 and 75 wt. % (**claim 23**); 10 and 30 wt. % (**claim 24**) of the substrate on a dry basis.

23. Fitting broadly discloses the use of activated carbon particles thus providing motivation for such and thus disclosing the general conditions of the claims. Giglia, at c. 1, ll. 65, teaches activated carbon particles present in an amount of between 15 and 80 weight % of the substrate on a dry basis and suggests that greater amounts provide greater adsorption of odors. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the particles of Fitting in amounts taught by Giglia in the claimed ranges for the desired degree of adsorptiveness with a reasonable expectation of success since it has been held that when the claimed range and the prior art range are very similar, (i.e. about 2 to 80 % and about 15 to 80 %), the range of the prior art establishes *prima facie* obviousness because one of ordinary skill in the art would have expected the similar ranges to have the same properties. See *In re Peterson*, 65 USPQ2d 1379, 1382.

24. The combination of Fitting, Dudley and Giglia disclose the claimed invention except for the carbon particles present in an amount of between 2 and 14 wt %. Fujinami teaches using activated carbon particles present in amounts of between about 1 to 8% (c. 3, ll. 46-49) up to 30% by weight (c. 4, ll. 39-40). One of ordinary skill in the art would expect greater amounts of

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the particles to provide greater adsorption or odors while lesser amounts would provide lesser degrees of adsorption, and that the inclusion of a particular range would depend on the intended final product. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the amounts of carbon in the claimed ranges since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.

Response to Arguments

25. Applicant's arguments with respect to claims 17-18, 22-28 and 32 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6. Dabi (US 4,992,326) teaches an odor sorbent substrate can be positioned within an absorbent core, as a baffle under the core, as a tissue wrap around the core, a pervious cover for the core, an adhesive strip under the baffle.

US 5,364,380 issued to Tanzer et al: teaches an odor sorbent powder composition positioned between a baffle and an absorbent core in a manner that the sides are coated with the composition.

7. Hu et al (WO 03/051414 A1) discloses durable activated carbon ink in personal care products wherein the odor sorbent substrate can be films, foams, and nonwoven webs.

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8. Karapasha et al (WO 91/12029) discloses durable activated carbon ink in personal care products in at least about 30% by weight of activated carbon particles.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginger T. Chapman whose telephone number is (571)272-4934. The examiner can normally be reached on Monday through Friday 9:30 a.m. to 6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ginger T Chapman/
Examiner, Art Unit 3761
10/21/09

/Tatyana Zalukaeva/
Supervisory Patent Examiner, Art Unit 3761